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10/596,284

06/08/2006

Krzysztof Skiba

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03/27/2008

POWER DEL VALLE LLP
233 WEST 72 STREET
NEW YORK, NY 10023

EXAMINER

MANSKAR, KRISTEN

ART UNIT

PAPER NUMBER

2875

MAIL DATE

DELIVERY MODE

03/27/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|---------------------------------------|---|--|
| Office Action Summary | Application No. 10/596,284 | Applicant(s) SKIBA, KRZYSZTOF | |
| | Examiner KRISTEN A. MANSKAR | Art Unit 2875 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 1/23/08 have been fully considered but they are not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a light clip to illuminate only a portion of the panel) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Regarding applicant's argument that Ohizumi does not explicitly disclose linear clamping arms, the Examiner respectfully asserts that the bottom arm (15 d) and the top arm (15) are linear (Figure 6). The claim language does not require the arms to be completely linear, therefore allowing for the angled break in the top arm.

2. Regarding the Applicant's argument that the Furihata reference does not explicitly disclose a light clip that illuminates only a portion of the plate, or having linear clamping arms, the Applicant is respectfully advised that it is noted that the features upon which applicant relies (i.e., a light clip to illuminate only a portion of the panel) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, a certain portion of the arms of Furihata are linear, and the claim language again does not explicitly require the arms to be completely linear across a plane.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 1, 3, and 4** are rejected under 35 U.S.C. 102(b) as being anticipated by Furihata (Patent 6,309,081), hereafter referred to as Furihata.

5. With respect to claim 1, Furihata discloses a lighting clip (300) fixed on portion of an edge (see Figure 1b with clip 300 not completely covering the edge of the light guide plate) of a transparent or semi-transparent panel (20) in a removable or permanent way (Figure 3), and supplied by an electric power system (Figure 4), said clip comprising a section having one side open (see Figure 1c, side open to light guide plate), a first linear clamping arm (301; Note a portion of the clamping arm is linear) and a second linear clamping arm (301; Note a portion of the clamping arm (portion parallel to light guide plate) is linear) joined with a connector (see rounded connector separating arms 301 in Figure 1), and an internal space (Figure 3b); said section equipped with at least one source of light (10) placed in the internal space (Figure 1c).

6. Regarding claim 3, Furihata discloses a clip wherein the section is in the form of an elastic, self-supporting shape (Column 8, Lines 6-9), the clamping arms (301) are of equal length (Figure 1), and both arms (301) are diagonal to an external surface of the panel (20). Note: please see end portion of the clamping arms comprising sections that are diagonal to the surface of the panel.

7. With regard to claim 4, Furihata discloses a clip (300) where both arms are parallel (Figure 1). Note that before the clamping arms branch out, the arms are temporarily parallel to one another.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 1 and 2** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohizumi, et al. (Patent 6,979,115), hereafter referred to as Ohizumi.

10. Regarding claim 1, Ohizumi discloses a lighting clip (Figure 6) fixed on an edge of a transparent or semi-transparent panel (12) in a removable or permanent way (Column 6, Lines 38-45), and supplied by an electric power system (Column 1, Lines 14-35), said clip comprising a section having one side open (see Figure 6, side open to light guide plate), a first linear clamping arm (15 c; Note a portion of the clamping arm is linear) and a second linear clamping arm (15d) joined with a connector (see connector noted by thickness A in Figure 5), and an internal space (Figure 5); said section equipped with at least one source of light (13) placed in the internal space (Figure 6).

11. Ohizumi does not explicitly disclose a lighting clip fixed on a portion of the edge, but across the entire length (Figure 4).

12. It would have been obvious to one of ordinary skill in the art at the time the invention was made to shorten the length of the clamping device, since it has been held

by the courts that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device, and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. *In Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984).

13. Regarding claim 2, Ohizumi discloses a clip wherein the section is in the form of an elastic, self-supporting shape (Column 3, Lines 60-65), the clamping arms (15 d and b) are of different lengths (Figure 6, Column 7, Lines 30-50), and the first clamping arm (15c) is diagonal to an external surface of the panel (Figure 6).

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

15. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 2875

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KRISTEN A. MANSKAR whose telephone number is (571)270-1220. The examiner can normally be reached on Monday-Friday 7:30a.m.-5p.m..

17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/KAM/

/Sharon E. Payne/

Primary Examiner, Art Unit 2875

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